

REMARKS

[0003] Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-56 are presently pending. Claims amended herein are 1, 3, 9, 13, 22, 25, 30, 34, 35, 36, 39, 43, 47, and 50. Claims withdrawn or cancelled herein are none. New claims added herein are 55 and 56.

Statement of Substance of Interview

[0004] The Examiner graciously talked with me—the undersigned representative for the Applicant—on November 20th. Applicant greatly appreciates the Examiner's willingness to talk. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

[0005] During the interview, I discussed how the claims differed from the cited art. Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments.

[0006] However, no agreement was reached and the Examiner indicated that any amendments would need to be presented in writing.

Formal Request for an Interview

[0007] If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

[0008] Please contact me or my assistant to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for us, I welcome your

call to either of us as well. Our contact information may be found on the last page of this response.

Claim Amendments and Additions

[0009] Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 3, 9, 13, 22, 25, 30, 34, 35, 36, 39, 43, 47, and 50 herein.

[0010] Furthermore, Applicant adds new dependent claims 55 and 56 herein. All amendments and these new claims in particular are fully supported by the Application and therefore do not constitute new matter. For example, claim language amended to clarify independent claims 1, 13, 25, 34, 43, and 50 and for newly added dependent claims 55 and 56 find support on page 16, paragraph [0068] and following.

[0011] Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to cited art. These claim amendments are fully supported by the application and therefore do not constitute new matter.

Formal Matters

[0012] This section addresses any formal matters (e.g., objections) raised by the Examiner.

Abstract

[0013] The Examiner objects to the Abstract for reasons stated on page 2 of the office action. Applicant disagrees with the need for this amendment, but in the interest of expedited prosecution, amends the Abstract herein to comply with the Examiner's request.

Substantive Matters

Claim Rejections under § 101

[0014] Claims 1-33, 42, and 50-54 are rejected under 35 U.S.C. § 101. In light of the amendments presented herein, Applicant respectfully submits that these claims comply with the patentability requirements of § 101 and that the § 101 rejections should be withdrawn. The Applicant further asserts that these claims are allowable. Accordingly, Applicant asks the Examiner to withdraw these rejections.

[0015] If the Examiner maintains the rejection of these claims, then the Applicant requests additional guidance as to what is necessary to overcome the rejection.

Anticipation Rejections

[0016] Applicant submits that the anticipation rejections are not valid because, for each rejected claim, no single reference discloses each and every element of that rejected claim.¹ Furthermore, the elements disclosed in the single reference are not arranged in the manner recited by each rejected claim.²

Based upon Lee

[0017] The Examiner rejects claims 1-5, 7, 11, 12, 25, 26, 28, 32-35, 37, 41-45, 49-52, and 54 under 35 U.S.C. § 102(b) as being anticipated by Lee (US 2003/0037331 A1). Applicant respectfully traverses the rejections of these claims. Based on the reasons given below, Applicant asks the Examiner to withdraw the rejection of these claims.

Independent Claim 1

[0018] The Examiner indicates (Action, p. 3) that independent claim 1 has been rejected as being anticipated by Lee. Herein, Applicant amends claim 1 to clarify the claimed correspondence between the unicast transmission and the target multicast transmission. Specifically, that the unicast transmission corresponds to the multicast transmission because it has content that is both analogous to and is synchronized with content of the target multicast transmission as follows:

“...receiving a unicast acquisition media-stream transmission, which corresponds to a target multicast media-stream transmission, the unicast acquisition media-stream transmission further comprising multimedia content that is analogous to and is synchronized with a content of the target multicast media-stream transmission;...”

¹ “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); also see MPEP §2131.

² See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

This correspondence is not found in the cited reference. Lee teaches a system and method for video on demand that permits scalability in which “users may first receive a dynamically initiated front portion of a video and then be merged into a pre-scheduled multicast,” (Abstract). The problem solved by the teachings of Lee does not require the “dynamically initiated transmission” to be at all synchronized with an in-progress multicast. To the contrary, Lee teaches that it contains a *front portion* of a video, meaning the video being multicast according to a predetermined schedule is cast anew (i.e. from the beginning) as a “dynamic transmission,” (Abstract).

[0019] Applicant submits that since Lee makes no explicit or inherent reference to synchronization between the dynamic transmission and an in-progress multicast, and in fact specifically teaches the opposite of synchronization, that Lee does not anticipate at least this portion of this claim. Consequently, Lee does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 2-12, and 55

[0020] These claims ultimately depend upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Independent Claim 25

[0021] The Examiner has cited the same reference and used similar reasoning to reject independent claim 25 (Action, p. 3). Herein, Applicant amends claim 25 to clarify the claimed correspondence between the unicast transmission and the target multicast transmission. In this case, that the unicast transmission and the multicast transmission have content that corresponds both in subject matter and in time as follows:

“...receiving a unicast acquisition media-stream transmission, where the content of the unicast acquisition media-stream transmission corresponds both in subject matter and in time to that of the target multicast media-stream transmission;...”

A similar line of reasoning (for the above referenced clarification) as is used for claim 1 applies to claim 25: Lee does not teach a unicast transmission that corresponds to a multicast transmission in the manner claimed.

[0022] Applicant submits that since Lee makes no explicit or inherent reference to time-wise correspondence and in fact specifically teaches the opposite of time-wise correspondence, that Lee does not anticipate at least this portion of this claim. Consequently, Lee does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 26-33

[0023] These claims ultimately depend upon independent claim 25. As discussed above, claim 25 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Independent Claims 34 and 50

[0024] The Examiner has cited the same reference and used similar reasoning to reject independent claims 34 and 50 (Action, p. 3). Herein, Applicant amends claims 34 and 50 similarly to clarify the claimed relationship between the unicast transmission and the target multicast transmission. Specifically, that the unicast transmission and the multicast transmission have content that corresponds to and is synchronized with that of the multicast transmission as follows (from claim 34):

“...receiving a unicast acquisition media-stream transmission, where the content of the unicast acquisition media-stream transmission corresponds to and synchronizes with that of the target multicast media-stream transmission;...”

Again, a similar line of reasoning as applied earlier to claim 1 applies to both independent claim 34 and independent claim 50.

[0025] Applicant submits that since Lee makes no explicit or inherent reference to synchronization (as was argued for claim 1) and in fact specifically teaches the opposite of synchronization, that Lee does not anticipate at least this portion of these claims. Consequently, Lee does not disclose all of the claimed elements and features of these claims. Accordingly, Applicant asks the Examiner to withdraw the rejection of these claims.

Dependent Claims 35-42, and 56; and 51-54

[0026] These claims ultimately depend upon independent claims 34 and 50. As discussed above, claims 34 and 50 are allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Independent Claim 43

[0027] The Examiner has cited the same reference and used similar reasoning to reject independent claim 43 (Action, p. 3). Herein, Applicant amends claim 43 to clarify that the claimed correspondence between the unicast transmission and the target multicast transmission is to a subsequent portion of the currently broadcast target multicast:

"...a receiver configured to simultaneously receive both a target multicast media-stream transmission and a unicast acquisition media-stream transmission, wherein the unicast acquisition media-stream transmission corresponds to a current transmission point of the target multicast media-stream transmission;..."

This claim amendment finds specification support particularly within paragraph [0068] on page 16 (as well as in the drawings) among other portions.

[0028] Further, it recites a difference which is not found within Lee. As noted previously, Lee teaches a system and method wherein the dynamically initiated transmission begins anew with content that starts from the beginning of the offered video, not from a current transmission point of the multicast as is claimed.

[0029] Applicant submits that since Lee makes no explicit or inherent reference to this type of correspondence and in fact specifically teaches the opposite of what is claimed, that Lee does not anticipate at least this portion of this claim. Consequently, Lee does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 44-49

[0030] These claims ultimately depend upon independent claims 43. As presented previously, claim 43 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Obviousness Rejections

Lack of Prima Facie Case of Obviousness (MPEP § 2142)

[0031] Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that not all of the criteria set forth for making a prima facie case have been met.

Based upon Jones and Smith

[0032] The Examiner rejects independent claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Chou (U.S. 6,637,031). Applicant respectfully traverses the rejection of this claim and asks the Examiner to withdraw the rejection of this claim.

Independent Claim 13

[0033] The Examiner indicates (Action, p. 11) that independent claim 13 has been rejected as being unpatentable over Lee in view of Chou. Herein, Applicant amends claim 13 to clarify the claimed correspondence between the unicast transmission and the target multicast transmission. Specifically, that the unicast transmission and the multicast transmission correspond both in time and in content as follows:

“...receiving a low bit-rate unicast acquisition media-stream transmission, which corresponds both in time and in content to a target normal bit-rate multicast media-stream transmission;...”

Claim 13 further includes the following claim elements:

- receiving a normal ~~bit-rate~~ unicast intermediate media-stream transmission, which corresponds to a target multicast media-stream transmission;
- switching reception from the unicast acquisition media-stream transmission to the unicast intermediate media-stream transmission;
- decoding the content of the unicast intermediate media-stream transmission;
- switching reception from the unicast intermediate media-stream transmission to the target multicast media-stream transmission.

[0034] As presented previously with regard to independent claim 25, Lee does not teach a system or method that utilizes or requires a unicast transmission that corresponds to a multicast transmission in the manner claimed. Lee specifically teaches a dynamically initiated transmission that includes a front portion of a video which has a starting point at the beginning of the video.

[0035] Additionally, no portion of the Lee reference explicitly teaches that the unicast transmission has any correspondence to a multicast transmission. Correspondence in this cited reference (Lee) is limited to that of the video itself (para. [0017]).

[0036] Further, no portion of Chou discloses this feature, and it is noted that the Examiner has not relied on Chou for this element.

[0037] Further still, the Examiner admits that Lee does not teach the “receiving, switching, decoding, and switching,” as recited in this claim. The Examiner therefore relies on Chou, which teaches using “at least two different audio/visual data streams” where “[t]he first data stream becomes available to a client much faster and may be more quickly displayed on demand while the second data stream is sent to improve the quality...” (Abstract).

[0038] On page 11 of the Action, the Examiner states that “it would have been obvious to combine Lee’s patching unicast, with Chou’s low-bit rate acquisition stream... to reduce the start-up or seek delay for interactive multimedia applications.” Applicant, however, submits that Lee and Chou do not teach or suggest all of the elements of this claim, as there exists no reason to combine these references in this way.

[0039] Consequently, neither Lee alone, nor Lee and Chou in combination disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

No Reason to Combine: No Showing of Objective Evidence

[0040] In addition to the cited arts failing to disclose each and every element of the rejected claim as discussed above, Applicant disagrees with the Examiner's reasoning in obviousness rejections. Applicant requests the Examiner's assistance to help to understand how to combine the cited references without the benefit of piecemeal consideration, hindsight reasoning, or using the Applicant's claims to acquire motivations to obtain the claimed results.

[0041] The Examiner acknowledges that Lee does not teach all of the features recited in this claim. The Examiner therefore relies on Chou to fill in the gaps, stating that the purported combinations would be obvious. Applicant disagrees.

No Reason to Combine References

[0042] "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. . . . KSR Int'l Corp. v. Teleflex, Inc., Slip Op. at 14 (U.S. Apr. 30, 2007) (quoting In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006)). A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning." Id., Slip Op. at 17, See also Graham v. John Deere Co., 383 U.S. at 36, 148 USPQ at 474.

[0043] Applicant submits that Examiner has not identified some suggestion, teaching, or reason from the cited references themselves (or from the knowledge of one of ordinary skill in the art at the time of the invention) that would have led one of ordinary skill in the art at the time of the invention (hereinafter, "OOSA") to combine the disclosures of the cited references in the manner claimed. More specifically, there is no reason to combine because:

- the cited art does not suggest the desirability of the claimed invention;
- the Examiner has not provided any objective and particular evidence showing why OOSA would have reason to combine the teachings of the references; and
- the cited art does not disclose all of the features of the claims.

[0044] Without conceding that any of the purported combinations are proper, particularly, Applicant disputes that the purported incorporation of Lee with Chou would have made the rejected claims obvious to one of ordinary skill in the art at the time of the invention. On page 3 of the Action, the Examiner states that:

"it would have been obvious to combine Lee's patching unicast, with Chou's low-bit rate acquisition stream... to reduce the start-up or seek delay for interactive multimedia applications."

Applicant disagrees that this combination would have made the rejected claims obvious at least because there is no evidence within the references themselves that the combination of Chou with the system of Lee would reduce the start-up or seek delay.

[0045] Accordingly, the Applicant respectfully asks the Examiner to withdraw the rejections of these claims.

Cited References Express no Reason to Combine

[0046] On page 11 of the Action, the Examiner states that it would be obvious to combine Lee's patching unicast with Chou's low bit rate acquisition stream, because it would "reduce the start-up or seek delay for interactive multimedia applications." Applicant disagrees that this combination would have been obvious to one of ordinary skill in the art at the time of the invention at least because Lee explicitly discloses reduced start-up and seek delay. Lee, citing test results obtained using their system and method declares: "Surprisingly, the results show that in all cases the latency is minimized...", (para. [0137]). Thus, OOSA would have no reason to look to Chou to solve a problem already solved by Lee.

[0047] The above statement draws on the reasoning of the BPAI presented in Ex parte Rinkevich (non-precedential decision) on May 29, 2007.

[0048] In its reasoning, the BPAI stated: "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning," (quoting KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d at 1397. See also Graham v. John Deere Co., 383 U.S. at 36, 148 USPQ at 474). In that case, as in the matter at issue here, the Applicant raised the issue of improper hindsight reasoning. Therein the BPAI was persuaded that the problem or deficiency that the Examiner raised as motivation to seek out a secondary reference, "impermissibly used the instant claims as a guide or roadmap in formulating the rejection." The BPAI further quoted the Supreme Court in KSR stating that "[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d at 1397. Applying common sense to the case at hand, the BPAI concluded that "a person of ordinary skill in the art having common sense at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill." Ultimately the BPAI found that the Examiner had impermissibly used the claim as a guide to formulate the rejection.

[0049] As in Ex parte Rinkevich, Applicant submits OOSA would have no reason to combine the teachings of Lee with Chou because neither reference expresses a reason to combine the teachings of these references, either explicitly or implicitly.

[0050] Furthermore, Applicant respectfully submits that the Examiner has not met his burden in showing a reason to combine Lee and Chou. More specifically, the Examiner has not identified any objective and particular evidence found in the cited references that show why one of ordinary skill in the art (OOSA) would have reason to combine the teachings of the two cited references.

[0051] The Examiner has not identified any specific portion of the cited references as being objective and particular evidence that would give OOSA reason to look towards the teachings of the other to produce the combination of references that the Examiner proposes. Applicant respectfully submits that the Examiner cannot maintain this obviousness-based rejection without pointing out, with particularity, the specific portions of the cited references that would have given OOSA reason to look towards the teachings of the other to produce the combination of references that the Examiner proposes.

[0052] For the foregoing reasons, Applicant submits that the Examiner has not met his burden in showing objective evidence to combine references. Accordingly, OOSA would have no reason to combine the teachings of cited references.

[0053] As shown above, the combination of Lee and Chou does not disclose all of the claimed elements and features of these claims. Accordingly, Applicant asks the Examiner to withdraw the rejection of these claims.

Dependent Claims 14-24

[0054] These claims ultimately depend upon independent claim 13. As discussed above, claim 13 is allowable. It is axiomatic that any dependent claim which depends from an

allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Conclusion

[0055] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call/email me or my assistant at your convenience.

Respectfully Submitted,

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